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Fax Transmission Cover Sheet

September 29, 2008

To

Examiner Harish T. Dass
USPTO

Telephone

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Fax Number

571-273-8300

From: Brennan K. Bradley
215.656.2401

Client-Matter Number:

308995-930001

Re: US Serial No. 09/970,600: DRAFT RESPONSE

Pages: - 10 - (including this form)

Docket: 1480-R-00

If there is a problem with this transmission, please call Nancy Núñez at 215-656-2409.

Message:

Examiner,

Enclosed please find an **Applicant Initiated Interview Request Form** and a proposed **DRAFT** Response in the above case.

Please confirm receipt of this fax via return fax or e-mail (ip.phil@dlapiper.com).

Best Regards,


Brennan K. Bradley

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(Form Rev. 8/02/04)

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Art Unit	: 3692	Customer No. 035811
Examiner	: Harish T. Dass	
Serial No.	: 09/970,600	Docket No.: 1480-R-00
Filed	: October 4, 2001	
Inventor(s)	: William H. Wisecarver, III	
	: Mary F. Nugent	Confirmation No.: 1951
Title	: SYSTEM AND METHOD FOR	
	: ON-LINE PAYMENT TRANSACTIONS	Dated: Draft

DRAFT RESPONSE – DO NOT ENTER

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is a response to the Office Action dated June 12, 2008 in relation to the above application.

DRAFT

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In the Claims

1. (Previously Presented) A computer implemented method for payment transactions between a consumer and a merchant comprising the steps of:

verifying electronically that the consumer has an established credit card account;

creating an electronic lock box account;

establishing a purchasing limit and storing the purchasing limit in the lock box account;

executing a purchase transaction having a dollar amount within the established purchasing limit; and

after executing the purchase transaction, requesting funds from the consumer's established credit card account and routing the funds to the merchant; and

wherein the lock box does not store funds.

2. (Previously Presented) A computer implemented method according to claim 1, wherein the step of creating an electronic lock box account further comprises creating an account number and access code, the method further comprising the steps of:

accessing a merchant via a computer network;

performing procedures for executing the purchase transaction;

entering the lock box account number;

entering the lock box account access code;

electronically routing the account number and access code to a service provider;

the service provider confirming the account number and access code;

verifying that the purchase dollar amount is within the established purchasing limit;

routing a request for funds totaling the dollar amount of the transaction to the customer's established credit card account; and

wherein the merchant does not have access to the credit card account and information regarding the credit card account.

3. (Previously Presented) A computer implemented method according to claim 1 further comprising the steps of:

receiving the requested funds from the consumer's established credit card account;

wiring the purchase dollar amount of the purchase transaction to the merchant less a discount fee; and

reducing the established purchasing limit in the lock box by the purchase dollar amount.

4. (Previously Presented) A system for e-commerce transactions comprising:

a network comprising, in communication, a consumer computer, a merchant computer, a credit card bank computer and a system provider computer;

the consumer computer in communication with the system provider computer for opening up a lock box account, establishing a purchasing limit, and storing the purchasing limit in the lock box account;

the system provider computer in communication with the credit card bank computer for verifying consumer credit card account information and for requesting and receiving funds for issuing payments to a merchant after a consumer executes a purchase transaction;

the consumer computer in communication with the merchant computer for executing purchase transactions totaling up to the established purchasing limit; and

the system provider computer in communication with the merchant computer for verifying consumer lock box account information and for issuing funds received from the credit card bank computer to pay for consumer purchase transactions;

wherein the lock box does not store funds; and

wherein the merchant does not have access to the credit card account and information regarding the credit card account.

5. (Previously Presented) A computer system for payment transactions between a consumer and a merchant comprising:

a system provider computer comprising:

means for verifying that a consumer has an established credit card account;

means for creating a lock box account for storing purchase limit information;

means for requesting funds from the consumer's established credit card account after the consumer executes a purchase transaction; and

means for routing the requested funds to a merchant computer; and

a consumer computer in communication with the system provider computer, said consumer computer comprising means for establishing a purchasing limit, said purchasing limit being stored in the lock box account; and

wherein the lock box account does not store funds.

6. (Previously Presented) A system according to claim 5, wherein the means for creating an electronic lock box account further comprises means for creating an account number and access code, the consumer computer further comprising:

means for accessing a merchant via a computer network;

means for performing procedures for executing a purchase transaction, said purchase transaction totaling a purchase dollar amount;

means for entering the account number;

means for entering the access code; and

means for electronically routing the account number and access code to the service provider computer, said service provider computer further comprising:

means for confirming the account number and access code; and

means for verifying that the purchase dollar amount is within the established purchasing limit; and

wherein the merchant does not have access to the credit card account and information regarding the credit card account.

7. (Previously Presented) A system according to claim 6, wherein the service provider computer further comprises:

means for receiving the requested funds from the consumer's established credit card account;

means for wiring the purchase dollar amount of the transaction to a merchant less a discount fee; and

means for reducing the established purchasing limit in the lock box by the purchase dollar amount.

Remarks

The claims are 1 – 7. No new matter is introduced herein.

As a preliminary matter, Applicants believe a brief overview of the prosecution history thus far in this case would be beneficial. This case has now been pending for seven (7) years (eight (8) years from the Applicants' perspective considering the October 13, 2000 filing date of the priority provisional application). Unfortunately, despite significant effort and cost on the Applicants' part, this case is no further along than it was seven (7) years ago. This application has been handled by two separate Examiners, and the current June 12, 2008 Office Action was the tenth (10th) action issued by the Patent Office in this case, which has required Applicants to submit ten (10) responses thus far. In general, prosecution has followed the course of an Office Action being issued, Applicants then successively overcoming all rejections, however rather than a Notice of Allowance being issued, a new Office Action would issue citing either new rejections not previously raised or new art uncovered following a supplemental search. It is important to note that Applicants' claims have remained substantially unchanged throughout this entire process. Nonetheless, Applicants have repeatedly tried to be accommodating by addressing the merits of each Office Action, despite the obvious questions why any such new issues or art were not previously raised, and also that the new prior art was merely cumulative over art already cited and of record. Applicants respectfully submit that this process has not only been inefficient resulting with significant effort and cost on Applicants' part to prosecute this Application, but runs contrary to the patent rules requiring an effective and efficient examination. (*see*, 37 C.F.R. § 1.104 (requiring an examiner's action to be complete with a thorough study and investigation to the subject matter) and *see also*, MPEP 707.07(f) (requiring an examiner to provide clear explanation of all actions taken during prosecution, answer the substance of an applicant's

argument in traverse when rejected, and provide reasons why a previous rejection is withdrawn). Thus, if an examiner states that an applicant's arguments are moot in view of new grounds of rejection, but merely repeats a similar analysis of rejection found in the prior action, then a clear explanation for rejection in answer to the substance of applicant's previous argument in traverse is not established. Also, new prior art cited in each additional action, pertaining to the same subject matter for the same claims, suggests that the initial search and analysis were not completely conducted. As a result, the impact of this perpetual process has deprived the Applicants the protection of a patent for which they are entitled under the law.

Claim 1 stands rejected under 35 USC §101 for the indicated reason that the claimed invention is directed to non-statutory subject matter. In particular, the Examiner has referred to In re Comiskey, 84 USPQ2d 1670 (Fed.Cir.2007). This rejection is respectfully traversed.

Applicants respectfully submit that In re Comiskey is inapplicable to Claim 1, as the subject matter of Claim 1 is directed to a machine, which is patentable subject matter. In particular, note the language "computer implemented method" recited in the first line of Claim 1. For this reason, Applicants respectfully solicit reconsideration and withdrawal of the rejection under 35 USC §101.

Claims 1 – 2, 4 – 6 stand rejected as being unpatentable over Cheong et al. in view of Hutchison et al. and Cohen. Claims 3 and 7 have been rejected under 35 USC §103(a) over Cheong, Hutchison and Cohen in view of Gustin et al. These rejections are respectfully traversed.

As an initial issue, Applicants submit that Cohen is not prior art to the present Application. In particular, Applicants understand that Cohen's only possible applicability could be under §102 (e), as the publication date of Cohen occurred after the present Application was

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filed. Cohen's effective filing date under §102 (e) is September 18, 2001. It is noted that Cohen is not entitled to priority of the filing date of the designated PCT application under §102 (e), which sets forth that "...applications published...resulting from an international application filed before November 29, 2000 shall not be effective as prior art as of the filing date of the international application." As the Cohen effective filing date is September 18, 2001, which is after Applicants' effective filing date of its priority provisional application on October 13, 2000, Cohen is not prior art. For this reason alone, Applicants respectfully solicit reconsideration and withdrawal of all claim rejections¹.

In view of all that is set forth above, the Applicants respectfully solicit favorable consideration of this Response and allowance of the present Application.

Respectfully submitted,

Paul A. Taufer
Reg. No. 35,703
Attorney for Applicants

PAT/nn
215-656-3385

¹ It is noted that the subject matter of Cohen is cumulative of other art cited in previous office actions